

REMARKS

With the entry of the present amendments, claims 1, 4-11, 14, 15, 18-22 are pending in the application. Claims 1, 11 and 14 have been amended. Claims 2, 3, 12, 13, 16 and 17 have been canceled. Claims 18-22 have been added. Support for the claim amendments may be found throughout the application as filed, including, but not limited to, paragraphs 12 and 17 and the Example.

In view of the following remarks, reconsideration and withdrawal of the rejections to the application in the Office Action is respectfully requested.

I. Rejection of Claims in view of Cantin

The Examiner has rejected Claims 1-4, 6-10 and 14-17 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,922,764, issued to Cantin *et al.* (hereinafter “Cantin”). Cancellation of Claims 2, 3, 16 and 17 renders the rejection moot with respect to these claims. In view of the present amendments, Applicant respectfully traverses the rejection of Claims 1, 4, 6-10 and 14-15.

In order to establish a *prima facie* case of anticipation, a cited reference must teach each and every limitation of the rejected claims. (MPEP 2131.) In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. (MPEP 2112 IV.) The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. (MPEP 2112 IV.)

Cantin neither expressly nor inherently teaches each and every limitation of independent Claims 1, 11 and 14. Amended Claims 1 and 11 recite a method for raising serum DHEA levels in an individual comprising applying a magnesium-containing composition to the individual's skin. The composition comprises magnesium chloride, a solvent, a gelling agent and glycerin, wherein the composition is *substantially free of sodium ions, sulfate ions or both*. Amended Claim 14 recites a composition comprising magnesium chloride, water, a gelling agent and glycerin, wherein the composition is *substantially free of sodium ions, sulfate ions or both*.

Cantin discloses a gel composition for treating the skin, scalp, hair, mucous membranes and/or nails comprising an electrolyte, including magnesium chloride, water, a gelling agent and glycerin. The Examiner has recognized that Cantin does not expressly teach the claimed limitation that the composition be substantially free of sodium ions, sulfate ions or both. Instead, the Examiner asserts that “this limitation is met because the Cantin patent does not mention the use of sodium ion in the composition and...numerous electrolytes could be selected besides those electrolytes with sulfate as the anion.” Applicants respectfully traverse.

First, contrary to the Examiner’s assertion, Cantin *does* teach the use of sodium ions in its compositions. (See col. 3, lines 40 and 56 and claims 7 and 10.) Second, the Examiner has provided no reasonable basis for the determination that compositions prepared according to Cantin are necessarily substantially free of sodium ions, sulfate ions or both. Instead, the Examiner suggests that one “could” prepare a composition free of these ions, provided one happened to select electrolytes with ions other than sodium or sulfate. “Inherency, however, may not be established by mere probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” (MPEP 2112 IV.) Because Cantin does not necessarily teach the claimed limitation that the composition be substantially free of sodium ions, sulfate ions or both, it cannot form the basis of an anticipation rejection under a theory of inherency.

Similarly, Cantin’s compositions do not inherently possess the same properties as the compositions recited in the amended claims. As discussed throughout the present application, Applicant has surprisingly and unexpectedly discovered that certain ions interfere with the ability of magnesium-containing compositions to increase serum DHEA levels. For example, sodium ions appear to “compete and interfere with the transdermal adsorption of the magnesium.” (See paragraph 17.) Similarly, compositions containing sulfate ions “did not have similar effects on DHEA levels.” (See paragraph 17.) Because sodium and sulfate ions interfere with the ability to raise serum DHEA levels and because Cantin’s compositions are not necessarily sodium-free or sulfate-free as discussed above, it follows that Cantin’s compositions do not necessarily or inherently possess the same ability to raise serum DHEA levels as the compositions recited in the amended claims. Accordingly, Applicant respectfully requests that the Examiner’s rejection under 35 U.S.C. § 102(b) of Claims 1, 4, 6-10 and 14-15 be withdrawn.

Finally, to the extent that the Examiner would suggest that it is obvious to modify Cantin's teachings to exclude sodium or sulfate ions in its compositions, Applicant respectfully traverses. The mere fact that a cited reference could be modified does not render the modification obvious unless the prior art suggests the desirability of the modification. (MPEP 2143.01 III.) Nothing in Cantin suggests that its compositions may be prepared substantially free of sodium ions, sulfate ions or both. Furthermore, because Cantin is directed solely toward providing cosmetic compositions with improved stability and feeling, its teachings provide no motivation to exclude sodium or sulfate ions in order to improve the ability of the composition to raise serum DHEA levels. (See col. 1, lines 62-64 and col. 2, lines 2-5.)

II. Rejection of Claims over Cantin in view of Alban

The Examiner has rejected claims 1-17 under 35 U.S.C. § 103(a) as being obvious over Cantin in view of U.S. Patent No. 5,420,118, issued to Alban *et al.* (hereinafter "Alban"). Cancellation of 2, 3, 12, 13, 16 and 17 renders the rejection moot with respect to these claims. In view of the present amendments, Applicant respectfully traverses the rejection of the remaining claims.

In order to establish a *prima facie* case of obviousness, three criteria must be met: (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. (MPEP 2142.)

Alban discloses a skin care composition comprising a humectant, a gelling agent, including methyl cellulose, and a silicone component. Alban neither teaches nor suggests that the compositions be substantially free of sodium ions, sulfate ions or both, a necessary limitation of independent claims 1, 11 and 14. Furthermore, because Alban is directed solely toward providing cosmetic compositions with improved feel and residue characteristics, its teachings provide no motivation to exclude sodium or sulfate ions in order to improve the ability of the composition to raise serum DHEA levels. (See col. 1, lines 11-12.) Therefore, neither Alban nor the combination of Cantin and Alban provides a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

III. Newly added Claims 18-19 and 20-22

Applicant respectfully asserts that new claims 18 and 19 are patentable over Cantin and Alban. Claims 18 and 19 recite methods for raising serum DHEA levels in an individual comprising measuring the level of DHEA, DHEA-S or magnesium in the individual and applying a magnesium-containing composition to the individual's skin. Because neither Cantin nor Alban teaches or suggests the step of measuring the level of DHEA, DHEA-S or magnesium in the individual, the cited references cannot anticipate or render obvious the claimed methods.

Applicant further asserts that new claims 20-22 are patentable over Cantin and Alban. Each of these claims recites a composition, or a method of using a composition, wherein the composition consists essentially of 25 to 35 weight percent magnesium chloride, a solvent (e.g., water), a gelling agent (e.g., methyl cellulose), and glycerin. Cantin, in contrast, teaches a composition that requires the presence of an "active agent." (See col. 3, line 66 through col. 4, line 51.) Although the term "active agent" is loosely defined in Cantin, it is clear that none of the components of claims 20-22 in the pending application fall into this category, because each of these is classified in a separate category, as either an electrolyte, a gelling agent, an adjuvant, or, simply, water. Therefore, because Cantin requires the use of "an active agent" in the compositions disclosed therein, Cantin does not render new claims 20-22 unpatentable.

In view of the foregoing remarks, Applicants respectfully submit that all of the claims remaining in the application are in condition for allowance and favorable action thereon is respectfully solicited.

Respectfully submitted,

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